



Paper No. 7

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In re Application of :
Roustaei, Lawrence, Lebaschi & Bian :
Application No.: 09/579,023 :
Filed: May 25, 2000 :
Attorney Docket No.: 15031.340 :
For: OPTICAL SCANNER FOR READING AND :
DECODING ONE-AND-TWO-DIMENSIONAL :
SYMBOLOGIES AT VARIABLE DEPTHS OF :
FIELD INCLUDING MEMORY EFFICIENT HIGH :
SPEED IMAGE PROCESSING MEANS AND :
HIGH ACCURACY IMAGE ANALYSIS MEANS :

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

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OFFICE OF PETITIONS

This is a decision on the petition under 37 CFR 1.47(a), filed July 24, 2000. The petition was forwarded to the Office of Petitions on January 22, 2002. The Office apologizes for the delay in addressing the instant petition and regrets any inconvenience caused petitioners by the delay.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on May 25, 2000 without an executed oath or declaration. Accordingly, on July 11, 2000, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on July 24, 2000 a declaration executed by 1 of 5 joint inventors, the surcharge, the petition fee, and the instant petition were filed. A declaration of facts of Daniel Basov, an attorney handling the prosecution of this application, accompanied the petition. Mr. Basov explains that all five inventors were mailed a copy of the complete application as filed, but only one, Donald Fisher, responded to the request that he sign the declaration for the patent application. Mr. Basov states the last known addresses for each inventor.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks items (1) and (2) above.

As to item (1), applicants have failed to establish that Inventors Lebaschi, Lawrence, and Bian have refused to sign the declaration or cannot be reached. A successful Rule 47 petition requires either (1) a clear refusal to join, whether expressly or by conduct, or (2) a showing of diligence in trying to find an unavailable inventor. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events. The Office requires that the non-signing inventors be provided with a complete copy of the application as filed. Mr. Basov's statement of facts indicates that the mailings to Mr. Lebaschi and Mr. Bian were returned unopened. This statement is vague in that the Office cannot determine if Messrs. Lebaschi and Bian identified the correspondence and returned it to Mr. Basov's firm because they would not even open it or if the United States Postal Service returned it to petitioners because it was undeliverable. A forwarding address should have been requested. If the papers were returned, and other attempts to locate the inventors, e.g. through e-mail, computer searches (such as LEXIS), or the telephone continue to fail, then applicants will establish that the inventors cannot be reached.

With respect to Mr. Lawrence, did petitioners attempt to reach Mr. Lawrence other than through the original mailing on May 16, 2000? The Office cannot ascertain whether Mr. Lawrence has refused to join or cannot be located.

When it is concluded by the 37 CFR 1.47 applicants that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration submitted with the present petition identifies each inventor individually on a separate sheet of paper without any reference to the other joint inventors. The declaration should set forth all of the joint inventors on the same page or number each page to show there are multiple pages in the declaration (i.e. 1 of 3; 2 of 3; 3 of 3) to ensure that each named inventor is aware of the other named inventors of the subject matter. See 37 CFR 1.63. For this reason, an oath or declaration in compliance with 37 CFR 1.63 and 1.64 is still required. See MPEP 409.03(a).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
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Telephone inquiries should be directed to the undersigned at (703) 308-6712.



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for Patent Examination Policy